

REMARKS

In the response filed October 20, 2008, Applicants presented elections and identified certain claims (claims 1-27 and 31) as readable on the elected species. In reply, the Office in the current Notice indicated that this previous election and identification of claims readable on the elected species was non-responsive, because the identified listing of claims includes other non-elected species. Applicants respectfully disagree with the Office's position for the reasons noted below. Nonetheless, Applicants will first present the following new elections.

In response to the Notice of October 30, 2008 and the Restriction Requirement set forth in the Office Action of September 19, 2008, Applicants elect with traverse the invention of Group I, claims 1-27 and 31, drawn to a negative electrode for a non-aqueous secondary battery and a non-aqueous secondary battery.

In response to the Species Election Requirement, Applicants elect with traverse general species B), the negative electrode with a surface coating layer (e.g., as recited in claims 2, 4 and 5-7); and the Sub-Species 1) the specific active material of claim 8 (i.e., single Si or Sn) as the elected species for examination on the merits. It is believed that at least claims 2, 4, and 5-8 are readable on the elected species.

The reasons for traverse are as follows.

In response to the Notice and in traverse to the requirements, it should be noted that certain claims contain overlapping and related subject matter with respect to the identified groups and species. Also, certain claims could be considered to be generic and/or linking claims to the elected and non-elected species. Such claims are readable on both the elected species and the non-elected species. Accordingly, these claims should be examined to the extent they read on the elected species as per US practice (see, for instance, US restriction and election practice with respect to Markush listings, wherein a single claim can recite both elected and non-elected subject matter (MPEP 803.02)). In this regard, it is permissible for a claim to read on both the elected and non-elected subject matter, and be examined to the extent it reads on the elected subject matter.

For instance, claim 1 fully encompasses and reads on the elected species B.

Also, at the top of page 3 of the Office Action of September 19, 2008, the Office notes that claims 2, 4, and 8 read on species B. However, it is believed that at least claims 3, 6, 7, 14-27 and 31 are also readable on elected species B. In this regard, it should be noted that the Office did not identify these claims and the embodiments therein as belonging to a particular species. It is believed that these claims should be examined with

the elected invention species as they are included in elected Group I (claims 1-27 and 31).

Also, claims 14, 15, 25-27 and 31 appear to be independent of the grouping of species. It should be noted that claims 14, 15, 25-27 and 31 were not identified as belonging to a specific species.

In addition, claims 6, 7, and 16-24 depend on claim 2 and the elected species of claim 2. Thus, these claims should be readable on the elected species.

Further, it should be noted that the above-identified claims contain overlapping and related subject matter. As such, a search of one group of invention and/or a search of one species would necessarily overlap with that of another. Thus, it is believed that it would not require an undue burden on the Examiner to search and examine all of the claims and/or all species together in this application.

For these reasons, Applicants submit that the Office's requirements for restriction and election of species are improper. Thus, kindly search and examine of all the claims in their full scope together in this application.

In the event that the Office disagrees with the traversal and maintains the requirement, then kindly consider the possibility of rejoinder of the non-elected invention, upon a determination of allowance of the elected invention, per U.S. rejoinder practice (See M.P.E.P. § 821.04). Also, please consider

and examine an additional species, upon determination of allowance of the generic claims, in accordance with U.S. election of species practice.

Favorable action on the merits is solicited.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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